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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,560	12/01/2000	Matti Salmi	442-009972-US(PAR)	6683

7590 01/26/2005
Perman & Green
425 Post Road
Fairfield, CT 06430-6232

EXAMINER

JUNG, MIN

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,560

Applicant(s)

SALMI, MATTI

Examiner

Min Jung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14, 18, 19, 30-35 and 38-49 is/are allowed.
- 6) ☒ Claim(s) 15-17, 20-23, 27-29, 36, 37 and 50 is/are rejected.
- 7) ☒ Claim(s) 24-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 15-17 and 36-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, line 5, it seems that the term "parameter" is missing after the word "filtering" (the first occurrence).

In claim 36, last paragraph (clause), it seems that "and that" should be deleted.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 15-16, 20-23, 27, 29, and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by McCormick et al., US 6,421,709 (McCormick).

McCormick discloses a system and method for filtering junk e-mails. Specifically, regarding claims 15-16, McCormick teaches a terminal comprising means for establishing a telecommunication connection and for receiving electronic information through the telecommunication connection (Fig. 1), wherein the terminal comprises: means for receiving a filtering parameter (incoming e-mail stage shown in Fig. 1), which filtering parameter is related to the electronic information to be received (filtering parameter reads on e-mail addresses, for example. See col. 4, lines 17-53); means for automatically allowing or preventing the receiving of the electronic information on the basis of the filtering parameter and that the terminal is arranged not to receive the electronic information through the telecommunication connection when the filtering parameter denotes the electronic information being prevented. See col. 4, lines 17-59, McCormick teaches a "No Admittance List" and a "Guest List", and the incoming information is automatically compared to the lists so that it is either received or rejected. Note that the marking of the receiving of information as being allowed or prevented on the basis of a specific filtering parameter reads on the act of storing certain e-mail addresses in the "No Admittance List" and the "Guest List".

Regarding claims 20-21, McCormick's teaching as applied above also applies to this claim. For more specific explanation of applying the McCormick reference, the

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associating step is inherently done at the sending end by attaching its own address to the information, and the address (filtering parameter) is used to make the decision on whether to prevent or allow the receiving of the electronic information. See col. 4, lines 17-59. The receiving step reads on the mail distribution phase shown in Fig. 1, wherein the actual reception of the information into the in box folder or waiting room folder is shown.

Regarding claims 22 and 23, the class of number of classes reads on the e-mail addresses respectively belonging to "No Admittance List", and "Guest List" of McCormick.

Regarding claim 27, in McCormick, it is inherent that the device (a device that sends the e-mail) may be a server or a terminal.

Regarding claim 29, McCormick teaches a conventional e-mail message bearing its sender's address, which automatically indicates that it is a personal message.

Regarding claim 50, applying McCormick in this situation would be that the received e-mail message would read on the notification message claimed. Then, the filtering parameter reads on the sender's address included as a part of the e-mail message.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick.

McCormick as applied above fails to teach a terminal utilizing wireless data transmission means. However, wireless transmission technique is a well-known method of transmission and utilized commonly in today's telecommunications technology. And since it is well known to receive e-mails on wireless terminals, it would have been obvious for one of ordinary skill in the art at the time of the invention to implement the McCormick's system by applying wireless technology in order to make the system compatible with the widely spread wireless network.

Allowable Subject Matter

7. Claims 1-14, 18-19, 30-35, and 38-49 are allowed.

8. Claims 24-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 36-37 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Response to Arguments

10. Applicant's arguments with respect to claims 1-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Donohue patent, the Pollack et al. patent, the Dong et al. patent, the Barchi patent, the Lazaridis et al. patent, and the Stockwell et al. patent are cited for further references.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Jung whose telephone number is 571-272-3127. The examiner can normally be reached on Monday, Thursday, Friday 7:30 - 6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 703-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ
January 24, 2005


Min Jung
Primary Examiner